

### **REMARKS / ARGUMENTS**

Claims 1-40 are pending in the instant application, of which claims 1-31 are previously presented and claims 32-40 are new claims. Independent claims 1, 11, and 21 have been amended to clarify the claim language to further prosecution. Claims 2-10, 32-34, 12-20, 35-37 and 22-31, 38-39 depend directly or indirectly from independent claims 1, 11 and 21, respectively.

Support for the above claim amendments may be found in, for example, FIG. 1A and ¶¶ 0040-0041 of the present application. Support for the above new claims may be found in, for example, FIGs. 1B, 4-6 and ¶¶ 0043-0044, 0056, 0061, 0067 and 0073 of the present application. The Applicant respectfully submits that the claims define patentable subject matter.

Claims 1-31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,212,730 ("Boston"), in view of U.S. Patent No. 7,103,908 ("Tomsen"). The Applicant respectfully traverses these rejections at least for the reasons previously set forth during prosecution and at least based on the following remarks.

### **REJECTION UNDER 35 U.S.C. § 103**

In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure, Rev. 6, Sep. 2007 ("MPEP") states the following:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."

See the MPEP at § 2142, citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), and *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval). Further, MPEP § 2143.01 states that "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" (citing *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007)). Additionally, if a *prima facie* case of obviousness is not established, the Applicant is under no obligation to submit evidence of nonobviousness:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

See MPEP at § 2142.

**I. The Proposed Combination of Boston and Tomsen Does Not Render Claims 1-31 Unpatentable**

The Applicant now turns to the rejection of claims 1-31 as being unpatentable over Boston in view of Tomsen. The Applicant notes that the proposed combination of Boston and Tomsen forms the basis for all of the pending rejections.

**A. Independent Claims 1, 11, and 21**

With regard to the rejection of independent claim 1 under 103(a), the Applicant has amended claim 1 and submits that the combination of Boston and Tomsen does not disclose or suggest at least the limitation of “automatically displaying, without user interaction and prior to viewing at least a portion of said received advertisement, a notification of said received advertisement on said television,” as recited by the Applicant in independent claim 1.

The Examiner concedes the following:

“Boston teaches scheduling, based on times designated by content provider, an advertisement for viewing at the user's location (step 945 of Figure 9 described in Col 9 Lines 58-61), but does not teach automatically display, without user interaction, a notification of the advertisement on said television, after said receiving of the advertisement and scheduling based on input from a user provided after said display of said notification of said received advertisement.”

See the Office Action at pages 4-5. The Examiner relies on Tomsen to disclose Boston's above deficiencies and states:

“Tomsen teaches a method and system for allowing a user **to save content presented in an interactive television environment and allowing a user to defer viewing of a television advertisement to a later time** (Abstract). In particular, Tomsen discloses including triggers, resources, or announcements within **the content stream delivered from the broadcast source**, as disclosed in Col. 5 Lines 1-19. In addition,

Tomsen teaches presenting an announcement automatically to a user (i.e. Indicator 404 or Prompt 502) and without the user's interaction by way of the triggers contained in the broadcast stream during the presentation of Television Commercial 402, as shown in Figs. 4 and 5; with further reference to Col. 6 Line 25-Col. 7 Line 29 and Steps 1008-1010 of Fig. 10. Since the broadcaster designates and delivers the trigger information regarding the announcement, it is the Examiner's position that the user has no influence or control on when the announcement is initially presented. Tomsen further discloses that **based on the users interaction after the announcement is presented**, a user can select to defer viewing of the advertisement by saving the information to Set-top Box 152 (i.e. scheduling or planning to view at a later time) so that a user can refer to it at a later time or resume the transaction (as disclosed in Col. 7 Lines 8-29; with further reference to Col. 8 Lines 10-56)."

See the Final Office Action at page 5 (emphasis added). The Examiner relies on Tomsen, which discloses **saving the content (TV advertisement) presented**, such as **content streams delivered and broadcasted**. Therefore the Examiner alleges that Tomsen discloses the claimed automatically displaying, without user interaction, a notification of said received advertisement on said television. The Examiner relies for support on the following citation of Tomsen:

"As an example, while **the viewer is watching a television commercial** on a first screen, the viewer can defer a transaction, capable of being conducted on a second screen, related to **a product advertised in the television commercial** or defer the viewing of the television commercial itself. Information related to the television commercial may be saved in a shopping cart for subsequent processing. Later, when the viewer wishes to continue the transaction or view the television commercial, the viewer may retrieve the shopping cart information, replay the television commercial, and then complete of the previously deferred transaction."

See Tomsen in the Abstract (emphasis added). Tomsen, in the above citation, discloses that the advertisement content **has already been received and presented** to the user, at the same time when the notification is displayed. In this regard, Tomsen at

least still does not disclose or suggest "automatically displaying, ...**prior to viewing at least a portion of said received advertisement**, a notification of said received advertisement on said TV..," as recited in claim 1 by the Applicant. In this regard, the Applicant maintains that Tomsen still does not overcome Boston's deficiency.

Since Tomsen discloses that the advertisement has already been received and presented at the time of the notification, Tomsen also does not disclose or suggest "scheduling based on input from a user provided after said displaying of said notification, said received advertisement for viewing on said television within said home; and displaying media corresponding to at least a portion of said scheduled advertisement on said television based on said scheduling," as recited in claim 1 by the Applicant.

Accordingly, independent claim 1 is not unpatentable over Boston in view of Tomsen and is allowable. Independent claims 11 and 21 are similar in many respects to the method disclosed in independent claim 1. Therefore, the Applicant submits that independent claims 11 and 21 are also allowable over the references cited in the Office Action at least for the reasons stated above with regard to claim 1.

#### **B. Rejection of Dependent Claims 2-10, 12-20, and 22-31**

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 11 and 21 under 35 U.S.C. § 103(a) as being unpatentable over Boston in view of Tomsen has been overcome and requests that the rejection be

withdrawn. Additionally, claims 2-10, 12-20, and 22-31 depend directly or indirectly from independent claims 1, 11 and 21, respectively, and are, consequently, also respectfully submitted to be allowable.

## **II. Arguments to Allowability of New Claims 32-40**

Claims 32-34, 35-37 and 38-40 depend directly or indirectly from independent claims 1, 11 and 21, respectively, and are, consequently, also respectfully submitted to be allowable at least based on the above reasons.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 2-10, 12-20, and 22-40.

In general, the Final Office Action makes various statements regarding claims 1-40 and the cited references that are now moot in light of the above. Thus, the Applicant will not address such statements at the present time. However, the Applicant expressly reserves the right to challenge such statements in the future should the need arise (e.g., if such statement should become relevant by appearing in a rejection of any current or future claim).

**CONCLUSION**

Based on at least the foregoing, the Applicant believes that all claims 1-40 are in condition for allowance. If the Examiner disagrees, the Applicant respectfully requests a telephone interview, and requests that the Examiner telephone the undersigned Patent Agent at (312) 775-8093.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

Date: March 16, 2009

          / Frankie W. Wong /            
Frankie W. Wong  
Registration No. 61,832  
Patent Agent for Applicant

McANDREWS, HELD & MALLOY, LTD.  
500 WEST MADISON STREET, 34TH FLOOR  
CHICAGO, ILLINOIS 60661  
(312) 775-8093 (FWW)